

Serial No. 10/536,759
Atty. Doc. No. 2002P19550WOUS

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REMARKS

Claims 11, 15-17 and 19-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US pat. No. 6,173,491 (hereinafter Goodwater) in view of US pat. No. 6,237,835 (hereinafter Litwinski). Claim 12 stands rejected as being unpatentable over Goodwater and Litwinski and further in view of US publication No. 2001/0030224 A1 (hereinafter Eulenstein). Claim 14 stands rejected over Goodwater and Litwinski and further in view of US pat. No. 4,386,051 (hereinafter Edgington). Applicant appreciates the recognition of allowable subject matter in claim 13. Reconsideration of the rejections and allowance of all the pending claims is solicited in view of the following remarks.

Claim 11 is directed to a method for production of a component (1) having a surface (8). The method allows introducing a filling element (7) into the component through a first side of the surface of the component. The method further allows connecting the filling element to the component by a fixing method. During the fixing method of the filling element and component, a holder (13) is used to connect the filling element to the component at least temporarily. The holder has a first holding point (22 or 28) on the same first side of the surface of the component and a second holding point (25) on the filling element. The holder is removed after the filling element and component have been fixed.

The Office Action correctly acknowledges that Goodwater fails to disclose a holder (13) for connecting the filling element to the component. The Office Action then applies Litwinski to purportedly remedy the deficiencies of Goodwater. However, as discussed below, it is respectfully submitted that the Goodwater/Litwinski combination does not constitute an appropriate *prima facie* combination of references for rejecting claims under 35 U.S.C. 103(a). Moreover, it is respectfully submitted that the Goodwater/Litwinski combination teaches away from the claimed invention.

Litwinski is directed to method and apparatus for backing up a friction stir weld joint. Accordingly, Litwinski describes a backing member 40. However, as seen in the various drawings of Litwinski and described by Litwinski at col. 5, lines 44-47, and at col. 7, lines 37-39, this backing member 40 is arranged such that the workpieces 21 are "sandwiched" between the backing member 40 and a rotatable shoulder 24, which in part is used to capture the plasticized

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material. See col. 5, lines 2-5 and col. 6, lines 59-62. There is no description anywhere in Litwinski that plasticized material is introduced through any surfaces of the workpieces. As best understood by applicant, the step of introducing a filling element into the component through a first side of the surface of the component is inapplicable to friction stir welding being that a rotating tool is used to generate sufficient frictional heating to form a region of plasticized material. See Litwinski col. 1, lines 18-22. The backing member 40 of Litwinski is simply used to constrain plasticized material (See Litwinski col. 5, line 16-18) formed in the weld joint and does not meet the structural and/or operational relationships of using a holder that connects the filling element to the component, as set forth in claim 11. Thus, the backing member of Litwinski is structurally, functionally, and operationally inapposite to the holder of applicant. If one were to use the holder of applicant, as the backing member of Litwinski, then the result would be a non-working device since the holder of applicant is not designed to constrain plasticized material but is designed to connect the filling element to the component by way of holding points. Moreover, it is a physical impossibility for the component of the present invention to be "sandwiched" as required by Litwinski being that the holder of applicant is configured to have its holding points on the same surface through which the filling element is introduced, not between mutually opposite surfaces of the workpiece as described by Litwinski.

Applicant respectfully notes that the claimed invention does not merely recite a first side of the surface of the component but specifically recites structural and/or operational relationships associated with such a first side. Namely, this first side of the surface is arranged to both 1) allowing the introduction of the filling element (as noted above, this step appears to be wholly inapplicable to friction stir welding) and 2) providing a holding point for the holder on that same surface. Once again, the sandwiching arrangement of the workpieces as required by Litwinski is a physical impossibility in the claimed invention. Accordingly, since the Goodwater/Litwinski combination is either of limited relevance and/or teaches away from the claimed invention, it is respectfully requested that the rejection of claim 11, as well as dependent claims 15-17 and 19-20 be withdrawn.

Regarding claim 12, it is noted that both the Goodwater and the Litwinski references appear to be directed to applications that need a seal (which is directly inapposite to applications with a gap) between the filling element and the component, as set forth in claim 12. See col. 5,

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lines 48-57 describing the sealing requirements of Litwinski, and col. 5, lines 9-14 describing the sealing requirements of Goodwater. Eulenstein is then applied to purportedly remedy the deficiencies of Goodwater and Litwinski. It is respectfully submitted, however, that one of ordinary skill in the art would not be motivated to combine Eulenstein, which describes a spacer to maintain a gap, with references that describe sealing between the filling element and the component. Thus, it is felt that the Examiner is using the claimed invention as a template to combine the references being applied to deprecate the claimed invention. This, however, is not an appropriate standard for rejecting claims under 35 U.S.C. 103(a). Accordingly, it is respectfully requested that the rejection of claim 12 be withdrawn.

Regarding claim 14, it is respectfully submitted that Edgington fails to remedy the fundamental deficiencies of Goodwater and Litwinski discussed above. Accordingly, it is respectfully requested that the rejection of claim 14 also be withdrawn.


Conclusion

It is respectfully submitted that each of the claims pending in this application recites patentable subject matter, and it is further submitted that such claims comply with all statutory requirements and thus each of such claims should be allowed.

The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

Dated: 7/13/06

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